

REMARKS

Claims 1-4 are currently pending in this application, of which claims 1 and 3 are in independent format. In this Amendment A, Claims 1 and 3 have been amended.

In The Specification

The specification has been amended to correct an informality.

Rejection of Claims 1-4 Under 35 U.S.C. § 103(a)

Claims 1 and 2 stand rejected under 35 U.S.C. §. 103(a) as being allegedly unpatentable over *Giberson* (U.S. Patent No. 5,315,825) in view of the Applicants' alleged prior art admission. Claims 3 and 4 stand rejected under 35 U.S.C. §. 103(a) as being allegedly over *Giberson* (U.S. Patent No. 5,315,825) in view of *Bay et al.* (U.S. Patent no. 5,600,954) in further view of the Applicants' alleged prior art admission. Applicants disagree with the rejections and submit that the Examiner has not provided a prima facie case of obviousness.

The Examiner contends that the *Giberson* reference teaches a vent pipe in the top of the heat exchanger communicating with the oil reservoir. Additionally, the Examiner contends that it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of the *Giberson* reference with the alleged prior art disclosed in the "Background Section" of the present application.

Under M.P.E.P. § 2143, to establish a prima facie case of obviousness, The Examiner must meet three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference

teachings. Second, there must be a reasonable expectation for success. Finally, the prior art reference (or references when combined) must teach or suggest all the claimed limitations.

The *Giberson* reference teaches cooling oil that leaves the high-pressure side of the powered pumps by flowing the oil through heat exchangers in the form of coolers 50. The oil then passes through one of the filters of the duplex filter 53 to a header line, which provides the supply oil. Although the *Giberson* reference teaches the use of heat exchangers to remove heat from the oil, the Applicants respectively note that this reference does not teach the use of a vent pipe on the top of the heat exchanger, wherein the vent pipe communicates the heat exchanger with the oil reservoir. The Applicants submit that a process of venting heat exchangers is known. In the overall application of a fluid coupling connected to a fly wheel of a diesel engine which drives a mobile piece of equipment, however, using a vent pipe on top of the heat exchanger to communicate with the oil reservoir is new. As such, the *Giberson* prior art does not teach or suggest all the claim limitations of the present application.

Furthermore, an invention is not obvious where the Examiner fails to provide suggestions even if the prior art "could" have been combined. In re Fritch, 972F.2D 1260, 23 USPQ2D 1780 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. Id. Thus, the Examiner cannot simply cite different features of the claimed invention from different prior art sources without explaining the motivation to combine or modify the prior art references. Furthermore, the Examiner must provide specific reasons to support the

obviousness rejection. Ex parte Humphreys, 24 USPQ2D 1255 (B.P.A.I. 1992). The Examiner's rejection must be specific as to how one of ordinary skill in the art would have found it obvious to practice any specific method within the scope of the claims as of the filing date of the application. Id.

The Applicants submit that the Examiner has merely stated that the *Giberson* reference can be modified by the Applicant's alleged prior art admissions. The Examiner has not provided specific reasons or specific combinations to support any modification of the references. Furthermore, the prior art does not suggest any desirability of modifying the *Giberson* reference. The Background Section of the present application specifically discusses different types of speed control clutches for connecting and disconnecting the mills and engines. As noted, the present invention does not incorporate any type of mechanical clutch or mechanical torque limiter. The Background Section then discusses fluid drives for variable speed drives. The present invention, however, relates to constant speed drives. The Background Section then discusses fluid couplings intended to be used for "soft start" conditions, wherein jams are not to be encountered. As noted in the present invention, the present invention relates to a fluid coupling connected to a flywheel of diesel engine that drives a mobile piece of equipment. These mobile equipment pieces experience hard start conditions and experience material handling that results in increased pressure (such as jams and high induced stresses) applied to the diesel engine and the driven mobile piece of equipment.

Therefore, since the present invention relates to a fluid coupling for a mobile piece of equipment driven by a diesel engine for high impact applications, one skilled in

the art would not be motivated to seek out the teachings of the Background Section of the present application to combine with the *Giberson* reference. As previously stated, the Applicants acquiesce that venting heat exchangers is known in the art. However, communicating the heat exchangers with the oil reservoir by a vent pipe for use in a fluid coupling connected to the flywheel of a diesel engine that is driving the mobile piece of equipment is novel. For the reasons noted above, the Applicants submit that the Examiner has not established a prima facie case of obviousness. Accordingly, Applicants believe that amended independent Claims 1 and 3 are allowable over the cited references.

Dependent claims, by their nature, include all of the limitations of the parent independent claim and any intervening claims from which they depend. Claims 2 and 4 depend directly from independent Claims 1 and 3, and accordingly, are believed allowable under 35 U.S.C. § 103 (a) over the cited references for at least the same reasons as independent Claims 1 and 3.

If for any reason the Examiner is unable to allow the application on the next Office Action and feels that an interview would be helpful to resolve any remaining issues, the Examiner is respectfully requested to contact the undersigned attorney for the purpose of arranging such an interview.

Respectfully submitted,



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